

## **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed October 4, 2005. Claims 42-44 have been added. Claims 1-44 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **I. CLAIM REJECTIONS**

#### **A. Rejection Under 35 U.S.C. §102(b)**

The Examiner rejects claims 21-23 and 29 under 35 U.S.C. § 102(b) as being anticipated by *Lehman et al.* (United States Patent No. 6,198,633). "To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Because *Lehman* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

*Lehman* teaches an enclosure including a base 10, a top cover 12, support 14, card cage 16 and enabler 18. Col. 3, lines 34-36. The enabler 18 divides the cavity formed between the base and the card cage into several receptacle cavities in which different size adapter cards can be inserted. Col. 4, lines 48-55. *Lehman* discloses different types of enablers 18 shown in detail in Figures 5A and 5B. The enabler shown in Figure 5A is an enabler configuration for receiving

four small cards (3U) and one large card (6U) as illustrated in Figures 1, 4, and 6A. Col. 5, lines 26-29. The enabler shown in Figure 5B is an enabler configuration for receiving two small cards (3U) and two large cards (6U) as illustrated in Figure 6B. Col. 5, lines 22-26. These are two distinct interchangeable embodiments of enablers 18 for the different configurations shown in Figures 1, 4, 6A, and 6B. The enablers 18 are attached to the top surface 16' of the card cage using screws. Col. 4, lines 50-52. The type of cards (e.g. 3U or 6U) that can be housed within the card cage is dictated by the configuration of the enabler 18; and different enablers 18 (e.g. in Figures 5A and 5B) must be used depending on the desired configuration and types of cards. *See* col. 5, lines 22-29. Where a double wide card (6U) is desired, a different narrower enabler 18 is used eliminating the guides for the narrower cards, thereby allowing room for the double wide card. *See* Figures 5A and 5B.

The Applicant's invention includes the use of adapters that reconfigure a card guide to accommodate different width cards without requiring the replacement of the card guides as set forth in *Lehman*. For example, in direct contrast to *Lehman*, rejected independent claim 21 recites the following:

21. A card guide for use in an electronic equipment enclosure configured to receive one or more functional modules, each of which includes a corresponding card, the card guide having first and second sides and first and second ends and comprising:

(a) first and second support structures that cooperate to at least partially define a pair of channels configured to receive at least a portion of a card, one channel being located on either side of the card guide, the channels terminating short of the first end of the card guide so that a slot is defined that is interposed between the first and second support structures, and the first and second support structures further cooperating to define a receptacle in communication with the slot so that in a first card storage configuration, a card received in the electronic equipment enclosure by way of the receptacle is positioned in the slot such that the card straddles the card guide;

(b) a connecting member at least indirectly joined to one of the first and second support structures.

(Emphasis added).

The portions of *Lehman* relied upon by the Examiner do not establish that *Lehman* discloses a card that straddles the card guide as set forth in claim 21. The rejection has not established that either the single width cards (3U) or the double width cards (6U) straddle the

enabler 18 of *Lehman*. Rather, in *Lehman*, where a larger card is desired a narrower enabler 18 (i.e. that shown in Figure 5B of *Lehman*) is used to allow room for the larger card. Thus, the larger card does not straddle the enabler 18 in *Lehman*. Rather, a narrower enabler 18 shown in Figure 5B is used to allow room for the larger card.

Further, the Examiner has not established that *Lehman* discloses a slot as set forth in claim 21. The slot set forth in the claims and described in the Applicant's specification is to accommodate the double width or larger cards without requiring replacement of the card guides as in *Lehman*. In the instance that the Examiner feels that such elements can be found in *Lehman*, the Applicant respectfully requests that the Examiner provide a detailed explanation of where every element can be found, referring to reference numbers and column and line numbers for each element of every claim, as is required by 37 CFR 1.104. Since *Lehman* does not teach the card guide being claimed in this application, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn. Claims 22-29 depend from claim 21 and include each element of claim 21. Therefore, Applicant respectfully requests that the rejection of claims 22-26 and 29 be withdrawn at least for the same reasons as claim 21.

**B. Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 1-20, 28, and 30-41 under 35 U.S.C. § 103 as being unpatentable over *Lehman* in view of *Brooks* (U.S. Patent No. 6,661,673).

Applicants traverse the Examiner's rejection for obviousness on the grounds that the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims. According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (1994); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added). It is well established that “every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines.” *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970); *See also In re Wilson*, 165 USPQ 494 (CCPA 1970) (“all words in a claim must be considered in judging the patentability of that claim against the prior art”).

*Lehman* is discussed above. *Brooks* teaches a card guide 102 having a card guide base 202, one or more card guide ends 204, and a set of card guide rails 206. The card guide ends are shown in detail in Figures 2 and 3. The card guide ends 204 are colored and replaceable such that the color of the card guide ends 204 indicate to a user the slot capability which corresponds to the type of the card 106 that should be guided by the card guide path 201 of the card guide 102. Col. 5, lines 6-10.

By contrast to the presently claimed invention, neither *Lehman* or *Brooks* teach or suggest the element, “the adapter elements cooperating with the card guides so that a first card storage configuration is defined when the adapter elements are joined to the corresponding card guides, and a second card storage configuration being defined when adapter elements are present in only two of the card guides” as is presently recited in independent claim 1. (Emphasis added). Rather, the elements in Figure 5a of *Lehman* and adapter elements in Figure 2 of *Brooks* merely teach guiding elements, which have not been established to provide multiple configurations when joined to only two of the corresponding card guides as opposed all three of the card guides. Moreover, the card guide ends 204 of *Brooks* are used to indicate the type of card used in the slot, rather than reconfigure the slot for different card types. As a result, the Examiner has failed to establish that *Brooks* discloses adapter elements that reconfigure the storage configuration as set forth in claim 1.

Regarding independent claim 15, the Examiner has not provided the analysis required under MPEP 2183 for the means-plus-function limitation set forth therein. According to MPEP

2181, a claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

Claim 15 recites the following element: “means for facilitating definition of multiple card storage configurations, the means for facilitating definition of multiple card storage configurations facilitating definition of first and second card storage configurations at the at least one card storage level.” (Emphasis added). This element uses the phrase “means for”, is modified by functional language, and is not modified by sufficient structure for achieving the specified function. Therefore, the Examiner must apply the required analysis under MPEP 2183 to establish a *prima facie* case of equivalence. Since such analysis has not been provided, a *prima facie case* of obviousness has not been established by the Examiner.

Even still, the Applicants traverse the rejection of claim 15 because neither *Lehman* nor *Brooks* disclose a prior art element that performs the function specified in claim 15, is not excluded by an explicit definition provided in the specification for an equivalent, and is an equivalent of the means-plus-function limitation. For example, neither *Lehman* nor *Brooks* teaches a prior art element that is a structural equivalent of the corresponding element in the means-plus-function element described in the Applicant’s specification.

Regarding independent claim 30, neither *Lehman* or *Brooks* teach or suggest the element, “the adapter elements cooperating with the card guides so that a first card storage configuration is defined when the adapter elements are joined to the corresponding card guides, and a second card storage configuration being defined when adapter elements are present in only two of the card guides” as is presently recited in independent claim 30. (Emphasis added). Rather, the elements in Figure 5a of *Lehman* and adapter elements in Figure 2 of *Brooks* merely teach guiding elements, which have not been established to provide first and second card storage configurations as set forth in independent claim 30. Moreover, the card guide ends 204 of *Brooks* are used to indicate the type of card used in the slot, rather than reconfigure the slot for

different card types. As a result, the Examiner has failed to establish that Brooks discloses adapter elements that reconfigure the storage configuration as set forth in claim 30.

As set forth above, the Examiner has not established that the combination of *Lehman* and *Brooks* teaches, suggests, or obviates the elements of independent claims 1, 15, and 30 as is claimed. Moreover, the Examiner has not established that the adapters of Brooks, when combined with Lehman, would define first and second card storage configurations. In view of *Lehman's* and *Brooks* failure to teach every element, Applicants submit that the Examiner has failed to set forth a *prima facie* case for obviousness and respectfully request that the rejection be withdrawn. In the instance that the Examiner feels that such elements can be found in *Lehman* or *Brooks*, the Applicant respectfully requests that the Examiner provide a detailed explanation of where every element can be found, referring to reference numbers and column and line numbers for each element of every claim, as is required by 37 CFR 1.104.

Claims 2-14, 16-20, and 31-41 depend from claims 1, 15, or 30 and include every element of the claim from which they depend. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicants respectfully request the rejection of claims 2-14, 16-20, and 31-41 be withdrawn at least due to their dependence from one of claims 1, 15, or 30. Further, the Applicant respectfully request the rejection of claim 28 be withdrawn at least due to its dependence from claim 21.

The Examiner rejects claim 27 under 35 U.S.C. § 103 as being unpatentable over *Lehman* in view of *Brooks* further in view of *Navia et al.* (U.S. Patent No. 5,175,669). Claim 27 depends from claim 21 and includes each element of claim 21. Therefore, Applicants respectfully request the rejection of claim 21 be withdrawn at least for the same reasons set forth above regarding claim 21.

**CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 6<sup>th</sup> day of February, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. A. Jones', with a stylized flourish at the end.

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